

REMARKS

By this Amendment, Applicants cancel claims 16-19, 24, and 25, without prejudice or disclaimer of the subject matter therein, and amend claims 1 and 2. Claims 1-15, 20-23, and 26-28 remain pending in this application.

In the Office Action of December 15, 2004,¹ claims 20-23 and 26-28 were allowed; claims 1-6, 11, 12, 16-19, 24, and 25 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,477,475 to *Takaoka et al.* (“*Takaoka*”); claim 15 was rejected under 35 U.S.C. § 103(a) as unpatentable over *Takaoka*; and claims 7-10, 13, and 14 were objected to as being dependent upon a rejected base claim but were indicated as being drawn to allowable subject matter. Applicants acknowledge with appreciation the Examiner’s indication of allowable subject matter and address the objection and rejections below.

Section 102(e) rejection of claims 1-6, 11, 12, 16-19, 24, and 25

The rejection of claims 16-19, 24 and 25 is rendered moot by the cancellation of those claims. Further, Applicants traverse the rejection of claims 1-6, 11, and 12 under 35 U.S.C. § 102(e) because *Takaoka* fails to anticipate those claims. In order to properly anticipate Applicants’ claimed invention under 35 U.S.C. § 102, each and every element of the claim at issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Further, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim[s].” *See* M.P.E.P. § 2131. Finally, “[t]he elements must be arranged as required by the claim.” *Id.*

Independent claim 1, as currently presented, recites a combination including:

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether or not any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

... [a] node device [that] comprises: transmission means for sending position information generated by the GPS device to the management device; and control means for receiving a control signal generated by the management device according to the position information sent from the transmission means and controlling respective sections of the radio unit according to the control signal; and ...

[a] management device [that] comprises: control signal generation means which receives the position information from the node device and generates the control signal for controlling respective sections of the node device that sent the position information according to the position information; and control signal transmission means which sends the generated control signal to a pertinent node device.

Applicants submit that *Takaoka* does not teach at least the “node device” and “management device” recited in claim 1. *Takaoka* is directed to a “fault point location system” (Abstract). *Takaoka*’s system includes “substations . . . to send information of transmission and distribution lines” and a “master station . . . to locate fault points” (Abstract). In rejecting claim 1, the Examiner noted *Takaoka*’s disclosure of a “substation 1” and a “master station 2” (Office Action “OA” at 2; *Takaoka*, col. 5, lines 1-40). Neither the cited disclosure nor any other disclosure in *Takaoka* teaches the claimed “node device” and “management device.”

Takaoka’s “substation 1” includes “GPS receiving means,” “time measuring means,” “surge detection means,” “self-position information transmitting means,” and “surge information transmitting means” (col. 5, lines 1-5). The “master station 2” includes “substation location information receiving means,” “substation surge information receiving means,” “map information storage means,” “TD [transmission and distribution] line map information preparing means,” fault section and location identifying means, and “TD line map information output means” (col. 5, lines 5-11). In *Takaoka*’s system, the master station receives the self-position and surge information from the substation, displays the location of the substation on the TD line map based on the self-position information, and, when it determines that a failure has occurred

on the power TD line based on the surge information, performs control for displaying that position on the latest power TD line map.

Even if *Takaoka*'s master station were construed as a "management device" and *Takaoka*'s substation were construed as a "node device," Applicants submit that *Takaoka* does not anticipate claim 1. *Takaoka* does not disclose that the master station includes means for generating a control signal for controlling respective sections of the substation that sent the position information according to the position information received from the substation, and means for sending the generated control signal to a pertinent substation. Furthermore, *Takaoka*'s substation merely transmits self-position information or surge information to the master station, the substation does not receive a control signal generated by the master station according to position information and control respective sections of a radio unit according to the control signal. For at least these reasons, Applicants submit that *Takaoka* does not teach at least a node device that comprises "control means for receiving a control signal generated by the management device according to the position information sent from the transmission means and controlling respective sections of the radio unit according to the control signal" and a management device that comprises "control signal generation means which receives the position information from the node device and generates the control signal for controlling respective sections of the node device that sent the position information according to the position information; and control signal transmission means which sends the generated control signal to a pertinent node device," as recited in claim 1.

Because *Takaoka* does not teach each and every element of claim 1, as a matter of law, it cannot anticipate that claim. As such, the rejection of claim 1 under 35 U.S.C. §102(e) based on *Takaoka* should be withdrawn. The rejection of dependent claims 2-6, 11 and 12 should be

withdrawn as well, for at least the same reasons as those presented above in connection with claim 1. Applicants request withdrawal of the § 102(e) rejection of claims 1-6, 11, and 12 and the timely allowance of those claims.

Section 103(a) rejection of claim 15

Applicants traverse the rejection of claim 15 because a case for *prima facie* obviousness has not been established. To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. *See M.P.E.P. § 2143.03* (8th ed. 2001). Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” *M.P.E.P. § 2143* (8th ed. 2001).

Claim 15 depends upon claim 1. For at least the reasons explained above, *Takaoka* does not teach or suggest each and every feature of claim 1. *Takaoka* therefore fails to teach or suggest each and every feature of claim 15, which includes all of the features of base claim 1. A case for *prima facie* obviousness has thus not been established with respect to claim 15.

Moreover, as affirmed by the Examiner, *Takaoka* fails to disclose that “the node device is an ATM communication device for communicating by an asynchronous transfer mode (ATM) transmission system, and the entire network is configured by an ATM network,” as required by claim 15.

In rejecting claim 15, the Examiner took Official Notice “of such standard for the system to conform to the well known standards for compatibility issues.” In response to the Examiner’s reliance on Official Notice, Applicants call attention to the provisions of *M.P.E.P. § 2144.03*, the

procedures set forth in the Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy dated February 21, 2002, and the precedents provided in *Dickinson v. Zurko*, 527 U.S. 150, 50 U.S.P.Q.2d 1930 (1999) and *In re Ahlert*, 424 F.2d, 1088, 1091, 165 U.S.P.Q. 418, 420 (CCPA 1970). An Official Notice rejection is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known. Further, any facts asserted as well-known should serve only to “fill in the gaps” in an insubstantial manner. It is never appropriate to rely solely on “common knowledge” without evidentiary support in the record as the principal evidence upon which a rejection is based. Applicants submit that the features required by claim 15 were not unquestionably well-known and that the Office Action has failed to demonstrate the contrary.

As M.P.E.P. § 2144.03 makes clear, with regard to Official Notice, “[t]he standard of review applied to findings of fact is the “substantial evidence” standard under the Administrative Procedure Act (APA)” (citations omitted). M.P.E.P. § 2144.03 points out that “an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support” (citations omitted). The Office Action does not provide substantial evidence on the record to show that Applicants’ claimed features were unquestionably well-known. Further, the Examiner’s conclusory statements regarding “well known standards for compatibility issues” is not supported by any evidence whatsoever.

Applicants therefore expressly traverse any taking of Official Notice and request that the Examiner either cite a competent prior art reference in substantiation of the conclusions in the Office Action, or else withdraw the rejection. To the extent the Examiner is relying on personal knowledge in alleging that certain subject matter was well known, Applicants request that the

Examiner provide an affidavit evidencing such knowledge as factually based and legally competent to support the Examiner’s conclusions. *See M.P.E.P. § 2144.03.*

The impropriety of the Official Notice notwithstanding, the Examiner has not established *prima facie* obviousness. Determinations of obviousness must be supported by evidence on the record. *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”). Further, the desire to combine or modify references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *See In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52).

In this case, the Examiner does not show that a skilled artisan considering *Takaoka*, and not having the benefit of Applicants’ disclosure, would have modified *Takaoka*’s system to include the features of claim 15. The Examiner’s allegations regarding conforming to “well known standards for compatibility issues” is not properly supported and does not show that a skilled artisan would have modified or implemented the reference in a manner resulting in the invention defined by claim 15.

Applicants call attention to M.P.E.P. § 2143.01, which makes clear that: “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (citations omitted). The Office Action does not show that the cited art “suggests the desirability” of a modification resulting in the combination of elements recited in claim 15. Applicants submit that the conclusions in the Office Action were not reached based on facts gleaned from the cited

references and that, instead, teachings of the present application were improperly used in hindsight to reconstruct the prior art.

For at least the foregoing reasons, *prima facie* obviousness has not been established with respect to claim 15 and the rejection of that claim under 35 U.S.C. § 103(a) should be withdrawn. Applicants thus request withdrawal of the § 103(a) rejection and the timely allowance of claim 15.

Objection to claims 7-10, 13, and 14

The Examiner objected to claims 7-10, 13, and 14 as being dependent upon a rejected base claim, indicating that those claims would be allowable if rewritten in independent form with the base and intervening claim recitations. Claims 7-10, 13, and 14 depend upon base claim 1, which is distinguishable from the applied art for at least the reasons presented above. Applicants therefore request withdrawal of the objection to claims 7-10, 13, and 14 and the timely allowance of those pending claims.

Conclusion

Applicants request the Examiner's reconsideration of the application in view of the foregoing, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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